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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,416	08/11/1999	JONATHAN DORFMAN	EWG-087	1373
<div>7590 BEH Investments LLC 1652 48th Street Brooklyn, NY 11204</div>				
			EXAMINER HUYNH, THU V	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/372,416

**Applicant(s)**

DORFMAN, JONATHAN

**Examiner**

Thu V. Huynh

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to communications: amendment filed on 06/12/07 to application filed on 08/11/1999, which is continuation in part of US patent 6,285,987.
2. Claim 18 is pending in the case.
3. All rejections in the previous office action have been withdrawn as necessitated by reconsideration.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,285,987 (hereinafter the**

Art Unit: 2178

**'987) in view of Angles et al., US 5,93,811, filed 08/20/96 and Brown, US 5,794,219, filed 02/96.**

**Regarding independent claim 1, the '987 teaches the steps of:**

- web page includes a reference to an advertisement server representing a request for the advertisement from the advertisement server (the '987, claim 6; "storing advertisements in a data base on a first server, said web pages having HTML references to said first server");
- selecting at the advertisement server the advertisement from among a plurality of advertisements, wherein the selection is based on competitive bidding among advertisers bidding among advertisers bidding (the '987, claim 6; "selecting the highest bid for placement of an advertisement on a particular web page");
- sending the advertisement to the browser, the browser superimposing the advertisement onto the web page (the '987, claim 6; "placing advertisement on web pages on word wide web which are accessed by a viewer utilizing a browser").

However, the '987 does not teach parsing the web page at a browser, a request for the advertisement from the advertisement server; receiving at the advertisement server an indication of the request; and the bidding occurs in real time.

Angles teaches:

- parsing the web page at a browser, wherein the web page includes a reference to an advertisement server representing a request for the advertisement from the advertisement server (Angles, col.8, lines 34-60; col.19, lines 20-40; parsing a web page at a web browser, wherein the web page includes an advertisement request

Art Unit: 2178

reference to advertising provider to request an advertisement from the advertisement provider);

- receiving at the advertisement server an indication of the request (Angles, col.8, lines 34-60; col.19, lines 20-40; advertisement provider advertisement request from the user);
- selecting at the advertisement server the advertisement from among a plurality of advertisements, wherein the selection is based on the user's profile (Angles, col.8, lines 56-61); and
- sending the advertisement to the browser, the browser superimposing the advertisement onto the web page (Angles, col.8, lines 62-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Angles' teaching into the '987's teaching, since the combination would have provided advertisement/banner/image based on user's profile and/or competitive bidding among advertisers.

Brown teaches bidding occurs in real time (Brown, col.1, lines 41-45; col.3, lines 30-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Brown' teaching into the '987's teaching, since the combination would have provided advertisement/banner/image based on competitive bidding in real time among advertisers.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2178

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al., US 5,93,811, filed 08/20/96 as provided by the examiner in “notice of reference cited” mailed on 05/19/06 and in view of Davis et al., US 20010042064 B1, priority filed 10/94.**

**Regarding independent claim 1, Angles teaches the steps of:**

- parsing the web page at a browser, wherein the web page includes a reference to an advertisement server representing a request for the advertisement from the advertisement server (Angles, col.8, lines 34-60; col.19, lines 20-40; parsing a web page at a web browser, wherein the web page includes an advertisement request reference to advertising provider to request an advertisement from the advertisement provider);
- receiving at the advertisement server an indication of the request (Angles, col.8, lines 34-60; col.19, lines 20-40; advertisement provider advertisement request from the user);
- selecting at the advertisement server the advertisement from among a plurality of advertisements, wherein the selection is based on the user's profile (Angles, col.8, lines 56-61); and
- sending the advertisement to the browser, the browser superimposing the advertisement onto the web page (Angles, col.8, lines 62-67).

Art Unit: 2178

However, Angles does not explicitly disclose selecting an advertisement based on competitive bidding among advertisers bidding in real time.

Davis teaches advertisement is selected based on competitive bidding in real time to fulfill a request (Davis, col.5, lines 62-65; col.18, line 37 – col.19, line 7; competitive bidding among advertisers is used to decide advertisements in the search result list).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Davis's advertisers bidding into Angles' teaching, since the combination would have provided advertisement/banner/image based on user's profile and/or competitive bidding among advertisers.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claim 18 have been considered but are moot in view of the new ground(s) of rejection.

Applicants point out that "claim 18 finds full support in the disclosure of the '979 application. Thus the effective filing date of the present application antedates the Davis reference by more than two year".

Examiner agrees. However, the combination of Angles and Davis (2001/0042064), which has priority date before 01/22/97, teaches such features as explained in the rejection above.


#### ***Conclusion***

Art Unit: 2178

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thu V. Huynh  
August 31, 2007